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Atty. Dkt. No. 026032-5052

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Smith et al.
Title: METHOD FOR MAKING A
VEHICLE PANEL
Appl. No.: 10/576,833
International Filing Date: 10/27/2003
371(c) Date: 04/24/06
Examiner: Vo, Hai
Art Unit: 1794
Confirmation Number: 2281

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed September 30, 2008, Applicant hereby provisionally elects Group II, Claims 26-34, for examination, with traverse.

The Examiner has required restriction between Claims 13-25 (Group I), drawn to a method of forming a panel, and Claims 26-34 (Group II), drawn to a component for a vehicle interior. Restriction was required because the Examiner alleged that the "inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the

following reasons: Claim 13 is anticipated or obvious over US 6,248,200.” Applicants respectfully disagree.

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in one application (35 U.S.C. § 121). In an application including claims directed to a process of making a product and a product, in order for the restriction to be proper, the Examiner must show (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process (M.P.E.P. § 806.05(f)). It does not appear that the Examiner has alleged either situation.

With regard to PCT Rule 13.1, the requirement of unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding features that define a contribution which each of the claimed inventions makes over the prior art (PCT Rule 13.2). It is unclear to Applicants how the present Application does not satisfy the requirement of unity of invention because independent Claims 13 and 26 each recite similar corresponding features, one in terms of a method of manufacturing, the other in terms of a product.


Applicants submit that the Examiner has failed to establish a prima facie case for why restriction is proper in the present Application, and respectfully request the Examiner to substantiate his/her position in greater detail. Otherwise, it is respectfully requested that the restriction requirement be withdrawn, and each of Claims 13-34 presently pending in the present Application be examined.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date October 30, 2008

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5349
Facsimile: (202) 672-5399

Andrew E. Rawlins
Attorney for Applicant
Registration No. 34,702